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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,304	10/22/2003	Terence Chen	CFP-2237 (15722/581)	2251

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EXAMINER

GEHMAN, BRYON P

ART UNIT PAPER NUMBER

3728

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,304

Applicant(s)

CHEN, TERENCE

Examiner

Bryon P. Gehman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6,8-10 and 12-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6,8-10 and 12-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-6, 8-10 and 12-23 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 8, lines 6, 7, 10 and 11, "the tool" is inconsistent with the preceding "at least one tool" of line 2, or lacks antecedent basis for one such tool.

In claim 10, line 2, "concave area" should be --concave portion--.

In claim 12, line 1, the claim is indicated to depend from itself.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 2-6, 8-10 and 14-16 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Krivec (5,535,881). Claims 2-4, 8-10, 12-14 and are rejected under 35 U.S.C. 102(b) as being anticipated by Ernst (5,638,964). Each discloses a tool-holding apparatus comprising a board (30; 3; respectively) and at least one holder (35 and 40; 8'), each holder comprising a root (40; 4') extending from the board, an inclined section (35; 5') extending obliquely from the root, a tip (35 below 38; 54') extending from the inclined section for pressing a tool, and a restraint (35 above 38; 7' and between 7' and

54') formed near the tip for restraining the tool, the root, tip and restraint being formed as a single integral piece and shaped like a curve, with the restraint and tip defining a planar abutment surface (35; 7' and 54'), and a concave portion (between adjacent elements 35 and 40 of different holders; between adjacent roots) near the root to receive the tool and the tip (35 below 38; 54') is separated from the concave portion by a gap for receiving the tool.

As to claims 2 and 3, each discloses multiple paired holders, each pair to hold a single tool.

As to claim 4, each discloses each root extending from the board.

As to claims 5 and 6, Krivec discloses a substantially horizontal section (45) and an inclined portion (35 or 37).

As to claim 9, each discloses the restraint including an obtuse protrusion (37; 54').

As to claims 10, 18, 20 and 22, each discloses first and second facets (top of 51 and portion extending therefrom to 30 nearer to the planar abutment surface, respectively; bottom surface of the concave portion and surface of 8' perpendicular thereto, respectively).

As to claims 14-16, Krivec and Ernst ('964) each disclose an obtuse protrusion (36; 7').

As to claims 17, 19, 21 and 23, the planar abutment surface (35; 7' and 54') is generally parallel to but spaced from the second facet (portion extending from top of 51 to 30 nearer to the planar abutment surface; surface of 8' perpendicular thereto) with

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the second facet extending perpendicularly from the first facet (top of 51; bottom surface of the concave portion).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-6, 15-16 and 18-19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the Ernst ('964) reference. To modify the shape of the Ernst holder to comprise a horizontal section between elements 4' and 7' would have been a matter of design choice, as the shape is not seen to unobviously distinguish from the structure disclosed by Ernst or provide any new or unexpected utility from its shape.

As to claim 6, Ernst discloses an inclined portion (at 7').

As to claims 15 and 16, Ernst discloses an obtuse protrusion (7').

As to claims 18 and 19, Ernst discloses first and second facets (bottom surface of the concave portion and surface of 8' perpendicular thereto, respectively) with the planar abutment surface (7' and 54') generally parallel to but spaced from the second facet (surface of 8') with the second facet extending perpendicularly from the first facet (bottom surface of the concave portion).

7. Claims 12 and 13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to any one of the preceding claims above, and further in view of either one of McCann (5,598,924) and Ernst (2002/0124910). McCann and Ernst ('910) each disclose an ear (21; 2 and 3) extending from a similar tool-holding apparatus board (20; 1). To modify the board of either one of Krivec or Ernst ('964) employing an ear as taught by either one of McCann and Ernst ('910) would have been obvious in order to render the apparatus suspendable, as taught by either one of McCann and Ernst ('910).

As to claim 13, Krivec discloses an obtuse protrusion (36) formed on the restraint (35 above 38) and spaced from the tip.

8. Applicant's arguments filed April 5, 2005 have been fully considered but they are not persuasive. The amended language added to the claims is met by Krivec and Ernst ('964) as explained above. The utility of the tool-holding apparatus claimed does not appear to be unobviously altered by the differences in shape claimed.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4555.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Bryon P. Gehman". The signature is fluid and cursive, with the first name "Bryon" being more prominent than the last name "Gehman".

Bryon P. Gehman
Primary Examiner
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BPG